

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.114 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 10 has been canceled without prejudice or disclaimer, and the subject matter of such claim has been incorporated into each of independent claims 1, 2 and 17-19. Claim 14, which the Patent Office has indicated as containing allowable subject matter, has been amended to be in independent form. New claim 23 depends from claim 1 and recites the subject matter of original claim 14. Support for newly added dependent claim 24 can be found in the instant specification at least at page 27, lines 3-4. Entry of the foregoing amendments is appropriate at least in view of the fact that a Request for Continued Examination is being filed herewith. See 37 C.F.R. §1.114.

Claims 1-7, 9-13 and 15-22 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,140,076 (*Hatsuda et al*), as evidenced by <http://www.wovenwire.com/reference/particle-size.htm> (*Screen Technology Group*). As noted above, claim 10 has been canceled, and the subject matter of such claim has been incorporated into each of independent claims 1, 2 and 17-19. Withdrawal of this rejection is respectfully requested for at least the following reasons.

Independent claims 1 and 2 recite a particulate water retaining material for cultivating plant. Independent claims 17-19 recite a method for the production of a water retaining material for cultivating plant.

Hatsuda et al does not disclose or suggest each feature recited in independent claims 1, 2 and 17-19. For example, *Hatsuda et al* does not disclose or suggest that the solubility of (B) said polyvalent metal compound in 100 g of deionized water at 20°C

is more than 0 and not more than 10.0 g, as recited in the independent claims. In this regard, the Advisory Action and the Official Actions dated March 11, 2009 and November 16, 2009, do not address such claimed solubility characteristic of (B) said polyvalent metal compound. Such claimed subject matter was previously presented in (now canceled) claim 10.

As discussed in the instant specification, by employing a solubility of (B) said polyvalent metal compound in 100 g of deionized water at 20°C of more than 0 and not more than 10.0 g, for example, the absorption capacity of the water absorbent resin can be maintained at an acceptable level while allowing a plant to utilize an inorganic element. See paragraph bridging pages 26 and 27. *Hatsuda et al* has no recognition or suggestion of the significance of the solubility of the polyvalent metal compound in deionized water, let alone any result-effective relationship thereof with, for example, the release rate of a nutrient salt to the plant and the absorption capacity of the water absorbent resin. As such, it would not have been obvious to modify *Hatsuda et al* to arrive at the claimed solubility range by optimizing such solubility of the polyvalent metal compound.

Furthermore, it is far from certain that the compound of *Hatsuda et al* inherently possesses the claimed solubility in 100 g of deionized water at 20°C of more than 0 and not more than 10.0 g. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). In the present case, *Hatsuda et al* is completely silent concerning the solubility in deionized

water characteristic of a polyvalent metal compound. Simply put, the Patent Office is unable to show with the requisite certainty that the *Hatsuda et al* compound possesses the claimed solubility characteristic.

Screen Technology Group fails to cure the above-described deficiencies of *Hatsuda et al*. In this regard, the Patent Office has relied on *Screen Technology Group* for relating mesh size to particle size. Even if *Screen Technology Group* would have been combined with *Hatsuda et al* in the manner suggested by the Patent Office, the resulting combination nevertheless fails to disclose or suggest that the solubility of (B) said polyvalent metal compound in 100 g of deionized water at 20°C is more than 0 and not more than 10.0 g, as recited in claims 1, 2 and 17-19.

For at least the above reasons, it is apparent that the claims are non-obvious over *Hatsuda et al* and *Screen Technology Group*. Accordingly, withdrawal of the above §103(a) rejection is respectfully requested.

The dependent claims are allowable at least by virtue of their direct or indirect dependence from one of the independent claims. Thus, a detailed discussion of the additional distinguishing features recited in the dependent claims is not set forth at this time.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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